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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/549,704

09/19/2005

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EXAMINER

GULLEDGE, BRIAN M

ART UNIT

PAPER NUMBER

1619

NOTIFICATION DATE

DELIVERY MODE

08/21/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/549,704	<b>Applicant(s)</b> KURODA ET AL.	
	<b>Examiner</b> Brian Gulledge	<b>Art Unit</b> 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,12,13 and 15-29 is/are pending in the application.
- 4a) Of the above claim(s) 17-22 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,12,13,15,16,23 and 25-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/26/09; 7/14/09</u>  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Previous Rejections***

Applicants' arguments, filed May 27, 2009 and June 16, 2009, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

### ***Restriction after Action on the Merits***

Applicants' amendment and/or newly added claims necessitates a restriction to one invention that was not required of the claims that were originally examined. This application now contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1:

Group I, claim(s) 1, 3-5, 12-13, 15-16, 23, and 25-29, drawn to a cosmetic.

Group II, claim(s) 17-22, drawn to a method of preparing a cosmetic.

Group III, claim(s) 24, drawn to a method of reducing straining feel.

The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features. Group I (the cosmetic) recites the inclusion of the methyltrimethicone represented by formula (2), and this special technical feature is not shared by the inventions recited by Groups II or III. And Group II recites the preparation of the cosmetic that includes the

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preparation of a material of formula (1) from the silanes of formulae (A) and (B), a special technical feature not shared by Groups I or III.

Since applicant has received an action on the merits for the originally presented invention, this invention (Group I) has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 17-22 and 24 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper

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restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

### ***Priority***

The Examiner acknowledges the English-language translation of the foreign priority application JP 2003-074978 (filed March 19, 2003). The subject matter for some of the instant claims (1, 3, 12-16, and 23) is supported by the disclosure of this application, and as such the Auguste reference (US Patent Application Publication 2004/0197248; filed April 10, 2003) is not available as prior art for these instant claims. The disclosure of the above Japanese patent application does not support the subject matter of the remaining instant claims (4-5, 12-13, and 25-29), and as such the Auguste reference is still available as prior art for these claims.

To overcome the intervening prior art (the Auguste reference) the later-filed application must be an application for a patent for an invention which is also disclosed in the prior application. The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35

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U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, foreign priority application JP 2003-074978, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for instant claims 4-5, 12-13, and 25-29. Instant claims 4 and 5 recite further limitations to the volatile solvent, and these limitations are not supported by the foreign priority application. For example, this application discloses lower alcohols such as ethanol and isopropanol (paragraph [26]), but not the instantly recited propanol. Also, while the application disclosed volatile linear silicones (paragraph [26]), it did not disclose dimethylpolysiloxanes with 4 or 5 silicone atoms as instantly recited. Instant claim 12 and dependent claims 25-26 and 28 recite the inclusion of polybutene and amounts for the included pigments. The foreign priority application does not disclose the inclusion of polybutene, or the instantly recited amounts of pigment. Instant claim 13 and dependent claims 27 and 29 recite the inclusion of saccharides, and the foreign priority application does not disclose the inclusion of saccharides.

### ***Claim Objections***

Claim 25 is objected to because of the following informalities: the claim recites an average molecular weight “of *form* 500 to 2700.” The claim should recite “of *from* 500 to 2700.” Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> Paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 12-13 and 25-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.** Where values can vary depending on the basis for their determination, the claimed subject matter may be indefinite. See *Honeywell Intl. v. Intl. Trade Commn.*, 341 F.3d 1332, 1340 (Fed. Cir. 2003). (Holding that, where a claimed value varies with its method of measurement and several alternative methods of measurement are available, the value is indefinite when the claim fails to concurrently recite the method of measurement used to obtain it). Accordingly, the percent values recited by instant claims 12 and 13 are incomplete insofar as they do not specify the frame of reference used to measure them, e.g., are the amounts relative to the cosmetic composition as a whole or only relative to the ingredients instantly recited.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1, 3-5, 15-16, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jose et al. (PCT Patent Application Publication WO 00/64401).** Instant claim 1 recites a cosmetic comprising a siloxysilane of formula (1) and a trimethicone of formula (2) with the two present in a ration of from 5:95 to 90:10. Jose et al. discloses transfer resistant cosmetic compositions that provide a durable long lasting finish (page 1, lines 9-17). The pigmented composition comprises at least one compatible oil and at least two silicones (page 1,

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lines 24-26). The silicones disclosed by Jose et al. include those of the formula  $M_eT_f$  (page 1, line 29), and a specific taught example of this type is 1,1,1,3,5,5,5-heptamethyl-3-trimethylsiloxyl-trisiloxane (formula  $M_3T$ ) (page 8, lines 18-20). This silicone reads on the instantly recited formula (2). The silicones disclosed by Jose et al. also include those of the formula  $M_gQ_h$  (page 1, line 30), and the values for “g” and “h” include the instantly recited siloxysilane of formula (1) (which corresponds to the formula  $M_4Q$ ). Thus, the ranges for the values of “g” and “h” that are taught by Jose et al. overlap the instantly recited values ( $g = 4$  &  $h = 1$ ), and in cases involving overlapping ranges, the courts have consistently held that even a slight overlap in range establishes a *prima facie* case of obviousness. *In re Peterson*, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003). Jose et al. thus teaches the inclusion of the instantly recited siloxysilane and trimethicone in a cosmetic composition. And Jose et al. further teaches having the silicone of general formula  $M_3T$  present in from 1 to 8 wt% (page 8, lines 16-18) and the silicone of general formula  $M_4Q$  present in from 5 to 30 wt% (page 9, lines 10-11). These amounts provide relative amounts that overlap the instantly recited range.

The specific combination of features claimed is disclosed within the broad genera of silicones of the general formula  $M_3T$  and  $M_4Q$  taught by Jose et al. but such “picking and choosing” within several variables does not necessarily give rise to anticipation. *Corning Glass Works v. Sumitomo Elec.*, 868 F.2d 1251, 1262 (Fed. Cir. 1989). Where, as here, the reference does not provide any motivation to select this specific combination of variables, anticipation cannot be found.

That being said, however, it must be remembered that “[w]hen a patent simply arranges old elements with each performing the same function it had been known to perform and yields no

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more than one would expect from such an arrangement, the combination is obvious”. *KSR v. Teleflex*, 127 S.Ct. 1727, 1740 (2007) (quoting *Sakraida v. A.G. Pro*, 425 U.S. 273, 282 (1976)). “[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious”, the relevant question is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” (*Id.*). Addressing the issue of obviousness, the Supreme Court noted that the analysis under 35 USC 103 “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR v. Teleflex*, 127 S.Ct. 1727, 1741 (2007). The Court emphasized that “[a] person of ordinary skill is... a person of ordinary creativity, not an automaton.” *Id.* at 1742.

Consistent with this reasoning, it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have selected various combinations of silicones of the general formula  $M_3T$  and  $M_4Q$  from within the disclosure of Jose et al. to arrive at compositions “yielding no more than one would expect from such an arrangement”.

Instant claims 3-5 recite the further inclusion of a volatile solvent, and limitations to this solvent. Jose et al. discloses the inclusion of an oil (page 1, lines 24-26), and further teaches that the oil can be a volatile hydrocarbon oil such as isoparaffin (page 4, lines 25-28). Instant claim 15 recites the inclusion of a silicone-modified organic thickener, and Jose et al. discloses the inclusion of a wax, such as dimethicone behenate (silicone-modified and a thickener) (page 10, lines 18-19 and 30). Instant claim 16 recites the inclusion of a UV-ray protective component, and Jose et al. discloses the inclusion of a sunscreen in the cosmetic (page 11, lines 28-29). And instant claim 23 recites that the two silicones (of formulae 1 and 2) are present together in an

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amount from 0.5 to 60 wt%, and Jose et al. teaches that the silicones are present in from 15 to 60 wt% (page 6, lines 3-5).

**Claims 12-13 and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auguste (US Patent Application Publication 2004/0197284).** Auguste discloses cosmetic compositions that comprise the silicone compound 1,1,1,5,5,5-hexamethyl-3,3-bis(trimethylsiloxy)trisiloxane in a physiologically acceptable medium (page 10, claim 30), which is the siloxysilane of formula (1) recited by instant claims 12 and 13. Auguste discloses that the volatile silicone may be present in from 1 to 50 wt% (paragraph [194], lines 1-5). Auguste also discloses the inclusion of a pigment in from 5 to 25 wt% (paragraph [205], lines 1-7). Auguste further teaches that the composition can include a non-volatile oil (paragraph [198], lines 1-2), such as polyisobutene (paragraph [199], lines 1-5), in from 1 to 40 wt% (paragraph [199], last three lines). Thus, Auguste discloses all of the limitations of instant claim 12.

The specific combination of features claimed is disclosed within the broad genera of additional ingredients (pigments and non-volatile solvents) taught by Auguste but such “picking and choosing” within several variables does not necessarily give rise to anticipation. *Corning Glass Works v. Sumitomo Elec.*, 868 F.2d 1251, 1262 (Fed. Circ. 1989). Where, as here, the reference does not provide any motivation to select this specific combination of variables, anticipation cannot be found.

That being said, however, it must be remembered that “[w]hen a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious”. *KSR v.*

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*Teleflex*, 127 S.Ct. 1727, 1740 (2007) (quoting *Sakraida v. A.G. Pro*, 425 U.S. 273, 282 (1976)). “[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious”, the relevant question is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” (*Id.*). Addressing the issue of obviousness, the Supreme Court noted that the analysis under 35 USC 103 “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR v. Teleflex*, 127 S.Ct. 1727, 1741 (2007). The Court emphasized that “[a] person of ordinary skill is... a person of ordinary creativity, not an automaton.” *Id.* at 1742.

Consistent with this reasoning, it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have selected various combinations of pigments and non-volatile solvents from within the disclosure of Auguste to arrive at compositions “yielding no more than one would expect from such an arrangement”.

Instant claim 13 recites the above discusses siloxysilane of formula (1) and pigment, as well as a polyhydric alcohol, a sucrose fatty acid ester, and water. One cosmetic taught by Auguste includes 5 wt% glycerol (a polyhydric alcohol), 2 wt% sucrose stearate (a sucrose fatty acid ester), and water for the balance (paragraph [219], example 5). Auguste also teaches the amount of water can vary and be as low as 0.5 wt% (paragraph [202], lines 1-6). Thus, Auguste teaches all of the ingredients recited by instant claim 13, and the disclosed amounts either overlap or read on the instantly recited amounts.

Instant claims 26-27 and 28-29 recite the further inclusion of fluorine-modified silicone resin and a UV-ray protective component, respectively. And Auguste discloses the inclusion of

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both fluorosilicones (paragraph [199], six lines from the end) and sunscreens (paragraph [203], lines 1-9) in the cosmetic composition.

**Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Auguste (US Patent Application Publication 2004/0197284) as applied to claim 12 above, and further in view of Arnaud (US Patent 5,932,197).** Auguste teaches all of the limitations of instant claim 25 except for the molecular weight of the polybutene. Auguste is silent as to the molecular weight of the taught polyisobutene.

Arnaud discloses cosmetic compositions (column 1, lines 4-7) and the use of polybutene or polyisobutene polymers in said composition (column 2, lines 53-55). Arnaud teaches that the polymer employed has a molecular weight from 800 to 10,000 (column 2, lines 55-58), an amount that overlaps the instantly recited range.

Therefore, it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have used a polybutene in the composition disclosed by Auguste with the molecular weight taught by Arnaud. Generally, it is *prima facie* obvious to select a known material (polybutene/polyisobutene) for incorporation into a composition, based on its recognized suitability for its intended use (oil for use in cosmetic compositions). See MPEP 2144.07

### ***Conclusion***

No claims are allowed.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Gullledge whose telephone number is (571) 270-5756. The examiner can normally be reached on Monday-Thursday 6:00am - 3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BMG

/Frederick Krass/  
Supervisory Patent Examiner, Art Unit 1612